

## REMARKS

Favorable reconsideration and allowance of this application are requested.

### **1. Discussion of Amendments**

By way of the amendment instructions above, the pending claims have been revised so as to emphasize that the process is for producing an ethylene-propylene-nonconjugated diene terpolymer. Support can be found throughout the originally filed specification, for example at page 6, lines 4-7 as well as prior claim 13 (which has been canceled as redundant).

In addition, the preamble transitional phrase has been changed to the more open-end form "comprising" thereby rendering moot the Examiner's rejection advanced under 35 USC §112, second paragraph.

Therefore, upon entry of the amendment instructions above, amended versions of claims 1-3, 5-7, 10 and 16-17 will remain pending herein for consideration.

### **2. Response to 35 USC §102(b) Rejection**

The Examiner persists in his rejection of prior claims 2-3, 5-7 and 17 under 35 USC §102(b) as allegedly being anticipated by Tanaglia (EP 1013673). In addition, Tanaglia has been applied as an allegedly anticipatory reference under 35 USC §102(b), against pending claims 1, 10, 13 and 16.<sup>1</sup> Applicants respectfully disagree.

Tanaglia fails to disclose the claimed feature defined by claims 1 and 2 of "heating the kneaded mixture essentially containing the ethylene-propylene-nonconjugated diene terpolymer ... to introduce hydroxyl groups into the ethylene-

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<sup>1</sup> The rejection against claims 1, 10, 13 and 16 was alternatively advanced under either 35 USC §102(b) or 35 USC §103(a) based on Tanaglia.

propylene-nonconjugated diene terpolymer via hydrogen abstraction.” (emphasis added)

Each of the pending claims 1 and 2 herein requires EPDM, which inherently has an unsaturated double bond. The double bond protects the EPDM from being degraded by the peroxide. Therefore, a hydroxyl-modified ethylene-propylene-nonconjugated diene terpolymer is obtained. See examples 5 to 8 of the present specification.

In sharp contrast, all examples of Tanaglia merely uses EPM, which does ***not*** have an unsaturated double bond. See paragraph 0023 of Tanaglia. Tanaglia shows no experimental examples using EPDM.

Tanaglia teaches a simultaneous heating and mixing process in which an EPM and a peroxide are simultaneously mixed and heated. This causes degradation of the EPM. No hydroxyl-modified ethylene-propylene-nonconjugated diene terpolymer is obtained in Tanaglia. Rather, the simultaneous heating and mixing process degrades the EPM. See Table 1 of Tanaglia and paragraph 0001.

It should also be noted that, in order to introduce hydroxyl groups into EPM, which as noted previously does not have an unsaturated double bond, the simultaneous heating and mixing process of Tanaglia must be avoided. Instead, a statically heating process (for example, heating using a pressing machine) is effective. See examples 1 to 4 of the present specification. Tanaglia does not disclose or suggest such a heating process. Hence, claims 1 and 2 as amended are not anticipated by Tanaglia and as such, withdrawal of the rejection advanced against such claims under 35 USC §102(b) is in order.

### **3. Response to 35 USC §103(a) Rejection**

As noted above, claims 1, 10, 13 and 16 were alternatively rejected under 35 USC §013(a) as allegedly obvious from Tanaglia.

Applicants note in this regard that Tanaglia fails to show factually that the therein disclosed process produces a hydroxyl-modified ethylene-propylene-nonconjugated diene terpolymer. Instead, Tanaglia merely discloses and teaches a method for **degrading** an EPM and/or an EPDM. Tanaglia does not provide any hint to change the degradation method as disclosed therein to a method which produces a hydroxyl-modified ethylene-propylene-nonconjugated diene terpolymer. Accordingly, Tanaglia does not render the presently claimed invention obvious within the purview of 35 USC §103(a).

Withdrawal of the rejection advanced under 35 USC §103(a) is therefore respectfully requested.

#### 4. Fee Authorization

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

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